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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/697,753

10/29/2003

Wendy D. Stout

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PATENT DOCKETING 39/361
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EXAMINER

WONG, STEVEN B

ART UNIT

PAPER NUMBER

3711

MAIL DATE

DELIVERY MODE

04/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/697,753	Applicant(s) STOUT, WENDY D.	
	Examiner Steven Wong	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 8-12, 19-21, 24 and 38-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 13-18 and 22-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Mitchell (5,368,301). Note the basis for the rejection set forth in the Office Action mailed July 24, 2007. Regarding the amendment to claim 34, the pieces of Mitchell are inherently capable of being aligned on top of one another. It is noted that this limitation relates to the intended use of the device.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (5,368,301). Note the basis for the rejection set forth in the Office Action mailed July 24, 2007.
3. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell (5,368,301) in view of Jacoby (6,213,465). Note the basis for the rejection set forth in the Office Action mailed July 24, 2007.
4. Claims 1-7, 13, 16-18 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301). Note the basis for the rejection set forth in the Office Action mailed July 24, 2007.
5. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301) and Hassenbach (2,953,380). Note the basis for the rejection set forth in the Office Action mailed July 24, 2007.

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6. Claims 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301) and Gallant (6,517,071). Note the basis for the rejection set forth in the Office Action mailed July 24, 2007.

7. Claims 27-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301) and Ozrovitz (5,213,507). Note the basis for the rejection set forth in the Office Action mailed July 24, 2007.

8. Claims 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krisch (5,988,687) in view of Mitchell (5,368,301) and Ruben (5,746,429). Note the basis for the rejection set forth in the Office Action mailed July 24, 2007.

Response to Arguments

9. Applicant's arguments filed December 26, 2007 have been fully considered but they are not persuasive. The applicant argues that neither Krisch nor Mitchell teach a puzzle piece with an image, wherein the image is not a portion of an overall puzzle image. However, this argument is not persuasive as instant claim 1 fails to recite this particular limitation. Claim 1 defines a plurality of puzzle pieces which interlock together, the pieces having first and second surfaces wherein neither surface includes a portion of an overall puzzle image. Claim 1 fails to define that each piece must have an image thereon. Therefore the blank pieces as taught by Krisch provide the recited plurality of pieces because the blank pieces do not include a portion of an overall puzzle image thereon. Regarding the reference to Mitchell, this reference is relied upon merely for its teaching that it is known in the art of puzzles to form the pieces with a universal shape.

Regarding claim 34, the applicant argues that the amendment defining the pieces as being aligned on top of each other is not taught by the reference to Mitchell. However, this argument is not persuasive as this limitation relates to the intended use of the puzzle pieces. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, the universal pieces of Mitchell are capable of being placed atop one another and therefore Mitchell anticipates claim 34.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Wong whose telephone number is 571-272-4416. The examiner can normally be reached on Monday through Friday 7am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Steven Wong/
Primary Examiner, Art Unit 3711

SBW
April 4, 2008